

Amendment and Response

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Serial No.: 09/821,669

Confirmation No.: 4980

Filed: 29 March 2001

For: METHOD FOR MAKING A STEM WEB

Remarks

The Office Action mailed 16 November 2004 has been received and reviewed. Claims 42-49, 55, 58-60, and 64 are canceled, claims 11, 50 and 62 are amended, and new claims 71-82 are presented above. As a result, claims 11, 13-15, 22-32, 34-41, 50-54, 56, 57, 61-63, and 65-82 are pending. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowable/New Claims

Applicants thank the Examiner for notification to the effect that claims 32 and 34-40 have been indicated as allowable, and that claims 14, 55, 56, 60, and 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

In response, Applicants have amended independent claim 11 to include the recitations of allowable claim 60 (now canceled), thus placing independent claim 11 and its dependent claims 13-15, 22-31, 41, 61, and 80 in condition for allowance.

Applicants have also amended independent claim 50 to include the recitations of allowable dependent claim 55 (now canceled), thus placing independent claim 50 and its dependent claims 51-54, 56-57, and 81 in condition for allowance (with claims 52-54 being subject to the rejection under 35 U.S.C. § 112, first paragraph as addressed below).

Applicants have also amended independent claim 62 to include the recitations of allowable dependent claim 64 (now canceled), thus placing independent claim 62 and its dependent claims 63, 65-69, and 82 in condition for allowance (with claims 66-68 being subject to the rejection under 35 U.S.C. § 112, first paragraph as addressed below).

Applicants further note that independent claim 70 was objected to in the absence of a rejection over the prior art. As no rejection is presented with respect to claim 70, Applicants respectfully submit that it is also in condition for allowance along with new claim 71 dependent therefrom.

New independent claim 72 includes all of the recitations of independent claim 50 as presented along with the recitations of allowable dependent claim 56 (now canceled). Thus,

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Applicants respectfully submit that new independent claim 72 and its dependent claims 73-79 are in condition for allowance as presented (with dependent claims corresponding to claims 51-55 and 57 as presented).

New dependent claims 71 and 79-82 are presented to provide more comprehensive protection of the claimed invention. Support for these new dependent claims can be found in the application as filed at, e.g., page 6, lines 14-20 and Figures 3 & 4.

The 35 U.S.C. §112, First Paragraph, Rejection

Claims 52, 53, 54, 66, 67, and 68 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, it was alleged that there is no disclosure of entangling the polymeric region with the fibrous surface where the web comprises a film layer, an elastic film layer, or an elastic web. Further, it was alleged that there is no disclosure that the composite has the fibers on the outer layer and entangled with the polymeric regions. Finally, it was alleged that there is no support in the original Specification that indicates to one of ordinary skill in the art that the inventors had possession of a fibrous web structure comprising a film, elastic film or elastic web with the polymeric region entangled with the fibers of the web. This rejection is respectfully traversed.

The proper standard to consider in making a "written description" rejection is: "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." (*In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618, (Fed. Cir. 1989)). Applicants respectfully submit that the Examiner has taken too narrow a view of the specification in making the rejection, and that one of ordinary skill in the art, considering the entire specification, would recognize that Applicants did "possess" the inventions of claims 52, 53, 54, 66, 67, and 68 as required under § 112, first paragraph.

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To sustain this rejection the Examiner has the burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim* 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). In addition, it is well-established that "[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." M.P.E.P. § 2163.02.

The Examiner admits that webs with all of the features recited in claims 52-54 and 66-68 are disclosed in the specification, although it is asserted that the specification does not explicitly disclose a composite web in which "the composite has the fibers on the outer layer and entangled with the polymeric regions." Office Action, p. 3. It is also asserted that "[t]he only disclosure in the Specification of the polymeric region entangling with a fibrous major surface is that of example 13...." Office Action, p. 22 (emphasis in original).

In essence then, the only reasoning provided in support of this rejection is that the inventions of claims 52, 53, 54, 66, 67, and 68 are not explicitly described in the specification. As noted above, however, explicit descriptions are not necessary to meet the written description requirement of § 112, first paragraph.

Because the offered reasoning to support this rejection is insufficient, Applicants submit that the Examiner must provide some additional reasoning as to why, in view of Applicants' specification, one of ordinary skill in the art would not understand that substrates other than the explicitly exemplified orange construction paper (e.g., substrates including film layers as recited in claims 52, 53, 54, 66, 67, and 68) could also be used to achieve polymeric regions entangled with a fibrous surface – regardless of the exact composition of the web underlying the fibrous surface. And the Examiner must do so in view of the fact that all of the features recited in claims 52-54 and 66-68 are disclosed in the specification. Failure to provide such additional evidence or reasoning would require withdrawal of the rejection.

For at least the reasons presented above, Applicants respectfully submit that claims 52-54 and 66-68 do satisfy the written description requirements of § 112, first paragraph.

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Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The 35 U.S.C. §112, Second Paragraph, Rejection

Claim 59 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have canceled claim 59, thus rendering this rejection moot. Applicants do, however, reserve the right to pursue the subject matter of claim 59 in any related applications.

The 35 U.S.C. §§102 & 103 Rejections

Claims 11, 13, 22, 23, 25, 27-29, 31, 41, 42, 44-46, 48-51, 58, 59, 61-63, and 65 were rejected under 35 U.S.C. §102(e) as being anticipated by Shephard et al. (U.S. Patent No. 6,205,623). Claims 42, 45, 48-51, and 58 were rejected under 35 U.S.C. §102(b) as being anticipated by Murasaki (U.S. Patent No. 5,643,651). Claims 15, 43, 57, and 69 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shephard et al. (U.S. Patent No. 6,205,623) as applied to claims 11, 42, 50, and 62 above, and further in view of Morris (U.S. Patent No. 5,782,411) and/or Melbye et al. (U.S. Patent No. 5,077,870). Claims 24, 47, 52-54, and 66-68 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shephard et al. (U.S. Patent No. 6,205,623) as applied to claims 11, 42, 50, and 62 above, and further in view of Guay (U.S. Patent No. 4,714,096) Reich et al. (U.S. Patent No. 5,546,660), Yoshida (EP 0 233 364), King (WO 96/04812), and/or Goulait (U.S. Patent No. 6,080,347). Claims 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shephard et al. (U.S. Patent No. 6,205,623) as applied to claim 11 above. Claim 30 was rejected under 35 U.S.C. §103(a) as being unpatentable over Shephard et al. (U.S. Patent No. 6,205,623) as applied to claim 11 above, and further in view of Morris et al. (U.S. Patent No. 5,792,411). Claims 11, 13, 22, 23, 25-31, 41, 44, 46, 47, 50, 51, 54, 59, 61-63, 65, and 68 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) as applied to claims 11 and 42 above and further in view of Kennedy et al. (U.S. Patent No. 5,260,015). Claims 15, 43, 57, and 69

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were rejected under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) (optionally in view of Kennedy et al., U.S. Patent No. 5,260,015) as applied to claims 11, 42, 50, and 62 above, and further in view of Morris (U.S. Patent No. 5,792,411) and/or Melbye et al. (U.S. Patent No. 5,077,870). Claims 29-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) as applied to claim 11 above, and further in view of Morris et al. (U.S. Patent No. 5,792,411). Claims 24, 47, 52-54, and 66-68 were rejected under 35 U.S.C. 103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) (optionally in view of Kennedy et al., U.S. Patent No. 5,260,015) as applied to claims 11, 42, 50, 62 above, and further in view of Guay (U.S. Patent No. 4,714,096), Reich et al. (U.S. Patent No. 5,456,660), Yoshida (EP 0 233 364), King (WO 96/04812), and/or Goulait (U.S. Patent No. 6,080,347).

Applicants respectfully submit that, in view of the amendments to independent claims 11, 50, and 62, the rejections of claims 11, 13, 15, 22-31, 41, 50-54, 57, 61-63, and 65-69 are rendered moot. Furthermore, in view of the cancellation of claims 42-49 and 58-59, the rejections of those claims are also rendered moot. Withdrawal of these rejections are, therefore, respectfully requested.

It should be noted, however, that Applicants do expressly reserve the right to pursue the rejected subject matter in one or more continuation applications and do, therefore, reserve the right to contest any and all of the assertions made in support of these rejections.

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For: METHOD FOR MAKING A STEM WEB**Summary**

It is respectfully submitted that the pending claims 11, 13-15, 22-32, 34-41, 50-54, 56, 57, 61-63, and 65-82 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for

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By

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15th day of March, 2005, at 2:57 p.m. (Central Time).

By: Name: Rachel Gaylin-Gebhardt